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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,504	10/30/2003	Steven W. Trovinger	10991471-13	9590

7590 04/28/2006  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,504	<b>Applicant(s)</b> TROVINGER ET AL.	
	<b>Examiner</b> Patrick H. Mackey	<b>Art Unit</b> 3651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40,41 and 63-78 is/are pending in the application.
- 4a) Of the above claim(s) 64-70, 72-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40,41,63 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/06 has been entered.

### ***Election/Restrictions***

2. Newly submitted claims 64-70 and 72-78 are directed to inventions that is independent or distinct from the invention originally claimed for the following reasons: The newly submitted claims represent various Combinations (punching/cutting, then folding, then collecting, then registering, then unloading classified in class 493; punching/cutting, then collecting, then registering, then unloading with trimming classified in class 412; and punching/cutting, then collecting, then registering, then unloading with stapling classified in class 270) which don't rely on the particulars of the original Subcombination ("collecting, then registering, then punching/cutting, and then unloading" classified in class 83) originally claimed in the claims filed 10/30/2003.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 64-70 and 72-78 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 40-41, 63, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bober in view of Albright et al. Bober discloses a method for stacking sheets of printing media that includes collecting the sheets on a workpiece (79) sheet by sheet; registering (80, 81) the sheets on the workpiece sheet by sheet; and unloading the stack from the workpiece (see col. 4, lines 30-33). Bober discloses all the limitations of the claims, but it does not disclose punching a hole/cutting a notch in the sheets, sheet by sheet. However, Albright discloses a sheet punching/cutting device that punches/cuts sheets, sheet by sheet, before transferring the sheets to a finisher for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once (see col. 2, lines 35-48). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Bober by punching/cutting the sheets sheet by sheet, as disclosed by Albright, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

6. Claims 40-41, 63, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell et al. in view of Albright et al. Farrell discloses a method for stacking sheets of printing

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media that includes punching a hole/cutting a notch in sheets (see col. 11, line 67); collecting the sheets on a workpiece sheet by sheet (see col. 11, line 20 incorporating U.S. 4,595,187 by reference); registering the sheets on the workpiece sheet by sheet (see col. 11, line 20 incorporating U.S. 4,595,187 by reference); and unloading the stack from the workpiece (see col. 11, lines 15-19). Farrell discloses all the limitations of the claims, but it does not disclose punching a hole/cutting a notch in the sheets, sheet by sheet. Rather, Farrell is silent as to how the punching/cutting occurs. However, Albright discloses a sheet punching/cutting device that punches/cuts sheets, sheet by sheet, before transferring the sheets to a finisher for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once (see col. 2, lines 35-48). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Farrell by punching/cutting the sheets sheet by sheet, as disclosed by Albright, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

### ***Response to Arguments***

7. Applicant's arguments filed 4/6/06 have been fully considered but they are not persuasive.
8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Farrell and Bober by punching/cutting the sheets sheet by sheet, as disclosed by Albright, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'P. Mackey', with a large loop at the end.

Patrick H. Mackey  
Primary Examiner  
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April 26, 2006